

REMARKS

This Response is submitted in reply to the Office Action dated September 11, 2007. Claims 1 to 4, 6 to 12, and 15 to 25 are pending. The specification has been amended. No new matter has been added by these amendments. Terminal Disclaimers and a Supplemental Information Disclosure Statement are submitted herewith. Please charge deposit account 02-1818 for any fees which due in connection with the Terminal Disclaimers, the Supplemental Information Disclosure Statement, and this Response.

The Office Action provisionally rejected Claims 1 to 4, 6 to 12, and 15 to 25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 36 of U.S. Patent Application No. 10/327,538 (which has issued as U.S. Patent No. 7,303,469) to Kaminkow. For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections.

The Office Action rejected Claims 1 to 4, 6 to 12, and 15 to 25 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 1 to 26 of U.S. Patent No. 6,511,375 to Kaminkow. For purposes of advancing the prosecution of this application, Applicant elects to overcome such rejection through the enclosed Terminal Disclaimer. Such election shall not be deemed an admission as to the propriety or accuracy of the Office Action's conclusions or rejections.

The Office Action rejected Claims 1 to 4, 6, 9 to 12, 14, 21, 22, and 25 under 35 U.S.C. 102(b) as being anticipated by WO 98/09259 to Bennett.

Bennett discloses a slot machine that displays a tic-tac-toe game. The slot machine includes a plurality of player selectable zones and prizes associated with at least one of the zones. The slot machine displays an indicia in a zone selected by a player, the indicia being representative of the prize, if any, associated with that zone. The slot machine requires the player to select one or more zones to produce a game result. In the event that the game result is a winning result, the slot machine awards the prizes indicated by the indicia revealed in the zones selected by the player. In certain versions, the slot machine will include some zones which have a zero prize value such

that if randomly selected by the controller and selected by the player, no prize is awarded to the player.

Independent Claim 1 is directed to a gaming device including a display device, an input device, and a processor in communication with the display device and the input device. The processor programmed to: (a) cause a plurality of masked selections to be displayed to a player by the display device, (b) associate a plurality of different values with the masked selections prior to the masked selections being picked by the player and without displaying which values are associated with which selections, (c) enable the player to pick a plurality of the masked selections for a designated number of sets, the designated number being at least two, (d) form the designated number of sets of a plurality of the values, each set determined by the player picking a plurality of the selections for the set, wherein the plurality of values in each set are based on the values associated with the selections picked by the player for the set, (e) cause a display of each of the sets and the values in each set, (f) generate at least one award by selecting at least one but not all of the plurality of values in each one of the sets, and (g) provide the award to the player.

Bennett does not disclose a processor programmed to generate at least one award by selecting at least one but not all of the plurality of values in each one of the sets. Page 5 of the Office Action stated that Bennett discloses a gaming device that generates "a plurality of awards by selecting a plurality of but not all of the values in each one of said sets (selections bearing a prize are selected (e.g., 5 credits), whereas "zero prize" zones are not used to generate the awards(s); see at least p.2, ll. 17-19)." The Office Action appears to interpret Bennett such that if a player selects a zone that includes a zero value prize, the zero value does not add value to the player's award and the zero value prize would be excluded from the player's award calculation (i.e., the zero value prizes are not selected for each set). Contrary to the Office Action's contention, Bennett's slot machine selects all of the player's selections because "the player accumulates prizes for each square selected." Bennett page 2, lines 28 to 29. Bennett further reinforces that each player selection is used to calculate the award because Bennett discloses that "in the event that the player wins the game, by aligning three of the selected zones in a straight line, the machine will pay him a prize equivalent

to the sum of the prizes... displayed in the zones selected by the player." Bennett page 4, lines 15 to 18 (emphasis added). Therefore, Bennett generates an award by selecting all of the player selected zones, whether or not the zone is associated with a zero value prize. On the other hand, independent Claim 1 includes a processor programmed to generate at least one award by selecting at least one but not all of the plurality of values in each one of the sets. Accordingly, for this reason Applicant respectfully submits that independent Claim 1 is patentably distinguished over Bennett and in condition for allowance.

Claims 2 to 4 depend directly from independent Claim 1 and are also allowable for the reasons given with respect to independent Claim 1 and because of the additional features recited in these claims.

As the gaming devices of independent Claims 6, 9, 14, 21, and 25 each include, amongst other elements, a processor programmed to (1) generate a plurality of awards, by selecting a plurality of but not all of the values in each one of the sets (Claim 6), (2) generate a plurality of awards by selecting at least one but not all of the values selected from each one of a plurality of the different sets (Claims 9 and 14), (3) generate an award by selecting at least one but not all of the values in at least one set (Claim 21), or (4) generate awards from the sets by selecting at least one but not all of the values of the different sets (Claim 25), and Bennett does not disclose these elements, Applicant respectfully submits that for similar reasons to those described above with respect to independent Claim 1, the gaming devices of independent Claims 6, 9, 14, 21, and 25 are also patentably distinguished over Bennett and in condition for allowance.

Claims 10 to 12 and 22 depend directly from independent Claims 9 and 21 respectively and are also allowable for the reasons given with respect to independent Claims 9 and 21 and because of the additional features recited in these claims.

The Office Action rejected Claims 8, 15 to 20, 23, and 24 under 35 U.S.C. 103(a) as being anticipated by Bennett in view of U.S. Patent No. 6,345,824 to Selitzky.

Page 6 of the Office Action stated that Selitzky discloses "a game with a bonus feature wherein if the player's hand includes more than one bonus combination, only the highest ranking bonus combination is rewarded (see at least 7:1-13)." Pages 6 to 7 pf the Office Action concluded that it would have been obvious to one of ordinary skill in

the art to apply "only awarding the highest ranking bonus combination" as disclosed in Selitzky into the gaming machine of Bennett to provide more frequent, but smaller awards in Bennett without the need to pay large awards.

Applicant submits that regardless of whether or not it would have been obvious to incorporate Selitzky with Bennett, neither Bennett or Selitzky individually, nor the gaming device resulting from the combination of Bennett and Selitzky discloses, amongst other elements, a processor programmed to (1) generate a plurality of awards by selecting a plurality of but not all of the values in each one of the sets (Claim 8), (2) generate a plurality of awards by selecting at least one but not all of the plurality of values selected from each one of a plurality of the different sets (Claim 15), (3) generate a resulting award by selecting at least one but not all of the plurality of awards (Claims 16 and 18), or (4) generate a resulting award by selecting at least one but not all of the awards from the plurality of different sets (Claim 23). Moreover, it would not have been obvious to one of ordinary skill in the art to modify Bennett and Selitzky to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand, the gaming devices of independent Claims 8, 15, 16, 18, and 23 each include, amongst other elements, a processor programmed to (1) generate a plurality of awards by selecting a plurality of but not all of the values in each one of the sets (Claim 8), (2) generate a plurality of awards by selecting at least one but not all of the plurality of values selected from each one of a plurality of the different sets (Claim 15), (3) generate a resulting award by selecting at least one but not all of the plurality of awards (Claims 16 and 18), or (4) generate a resulting award by selecting at least one but not all of the awards from the plurality of different sets (Claim 23). Accordingly, for this reason and the reasons provided with respect to independent Claim 1, Applicant respectfully submits that independent Claims 8, 15, 16, 18, and 23 are patentably distinguished over Bennett in view of Selitzky and are in condition for allowance.

Claims 17, 19 to 20, and 24 depend directly or indirectly from independent Claims 16, 18, and 23 respectively and are allowable for the reasons given with respect to these independent claims and because of the additional features recited in these claims.

The Office Action rejected Claim 7 under 35 U.S.C. 103(a) as being anticipated by Bennett in view of Official Notice.

Page 7 of the Office Action stated that "The Examiner takes official notice that it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values." Regardless of whether it was well known in the art at the time to display the non-chosen values, in addition to the chosen values, Bennett does not disclose a processor programmed to generate a plurality of awards, by selecting a plurality of but not all of the values in each one of the sets. Moreover, it would not have been obvious to one of ordinary skill in the art to modify Bennett in view of Official Notice to result in such a gaming device without reasonably being construed as improper hindsight reconstruction. On the other hand the gaming device of Claim 7 includes, amongst other elements, a processor programmed to generate a plurality of awards, by selecting a plurality of but not all of the values in each one of the sets. Accordingly, for this reason and the reasons provided with respect to independent Claim 1, Applicant respectfully submits that Claim 7 is patentably distinguished over Bennett in view of Official Notice and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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Dated: December 11, 2007